

Appl. No. 10/620,307
Amendment Date: March 4, 2005
Reply to Office Action of October 5, 2004

REMARKS/ARGUMENTS

1. Claims 1 – 4 have been rejected under 35 USC 112, second paragraph as being indefinite. The Office Action indicates that these claims omit essential
5 steps, i.e. a procedure for installing the system on a vehicle. Applicant has amended Claims 1 – 3 to further clarify one variation of the present method where installing a system is performed in conjunction with performance of a government required inspection. Applicant respectfully submits that these are essential steps as described in the specification. Applicant respectfully
10 requests that the new formation of these claims be reevaluated and that the rejection of Claims 1 – 4 under 35 USC 112, second paragraph be withdrawn.
2. Claims 5 – 17 have been rejected under 35 USC 112, second paragraph as being indefinite. The Office Action indicates that these claims lack structural
15 cooperation between elements. Applicant has amended Claims 1 to further clarify one variation of the present method where the vehicle computer is programmed to disable the vehicle in the case of two different events; lack of a signal and receipt of a signal from a radio receiver. Applicant respectfully requests that the new formation of these claims be reevaluated and that the
20 rejection of Claims 5 – 17 under 35 USC 112, second paragraph be withdrawn.
3. Claims 1 and 2 have been rejected under 35 USC 103(a) as being unpatentable over US Patent No. 6,072,248 to Muise et al., in view of US
25 Patent No. 5,918,256 to Delaney et al.

30 Applicant notes that the burden of establishing obviousness rests on the Examiner. In order to support a *prima facie* case for obviousness using a particular set of references, the references must exhibit the following attributes:

- (a) The prior art references *must* collectively teach or suggest *all* of the *claim limitations* in the application;
- (b) There must be a reasonable expectation of success in modifying the reference; and
- 5 (c) The references must suggest or provide some motivation to modify and / or combine the reference teachings.

Here, the claimed invention is a method and apparatus for disabling a vehicle and installing a system for disabling the vehicle during a government required inspection. Delaney does describe a vehicle emission analysis system. Although Muise does describe a system for disabling a vehicle and Delaney does describe a system for analyzing emissions, the fact remains that neither reference teaches the installation of a system during performance of a government required inspection. As such, the *prima facia* case must fail since this feature of the claimed method is not described in either reference.

A *prima facie* case of obviousness further requires that there be found some motivation to modify and/or combine the reference teachings. This motivation can come from the references themselves. Here, no such motivation is found in either reference. The Office Action admits that Muise is silent on the matter of installing the system disclosed therein. Applicant can not find any such motivation in Delaney. As an alternative to finding motivation in the references themselves, the Office Action must put forth a convincing line of reasoning as to why the artisan would have been motivated by the reference teachings to make the modification or combine the reference teachings. Further, the Office Action has not provided any rationale that would support this alternative motivation requirement. The Office Action has merely stated that "it would have been obvious" to install the system during the inspection process. This statement, standing alone, is insufficient to establish a convincing line of reasoning. Accordingly, the Office Action has failed to

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establish a prima facie case of obviousness. Accordingly, Applicant requests that the rejection of Claims 1 and 2 under 35 USC 103 be withdrawn.

5 Applicant also notes that, in order to be used to sustain a rejection of a claim under 35 USC 103, a reference must be from an analogous art. Here, Musie and Delany are from entirely different fields of endeavor. The two references can not be combined in order to sustain the rejection of Claims 1 and 2 under 35 USC 103.

10 4. Claims 3 has been rejected under 35 USC 103(a) as being unpatentable over US Patent No. 6,072,248 to Muise et al., in view of US Patent No. 5,918,256 to Delaney et al., in further view of US Patent No. 6,371,000 to Hutmacher et al.

15 Applicant notes that Claim 3 is dependent on Claim 1. As such, Claim 3 must be found as non-obvious in light of Applicant's demonstration that Claim 1 is non-obvious.

20 5. Claims 5 has been rejected under 35 USC 102(b) as being anticipated by US Patent No. 6,072,248 to Muise et al. In order to anticipate the claimed invention, the reference must disclose each and every element of the claimed invention. Also, in order to anticipate a claimed invention, the cited reference teachings must be indistinguishable from and be capable of performing the same function as the claimed invention.

25 Here, Musie discloses an apparatus wherein a fuel control system is disabled according to a radio signal. In fact, Musie specifically states that a signal is applied to the fuel control section (Column 3, Lines 46 – 53). In the claimed invention, an ignition control computer is disabled according to a radio signal.

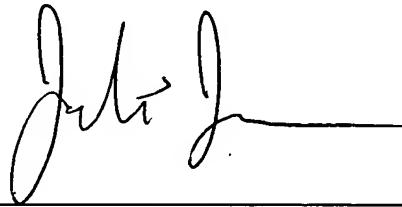
30 It is clear that an ignition control computer is entirely distinct in function from a

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fuel control system. In the claimed invention, it is the ignition that is disabled. The teachings of Musie do not contemplate disablement of an ignition system and are not capable of doing so. Accordingly, Applicant submits that the rejection of Claim 5 under 35 USC 102 should be withdrawn.

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Respectfully Submitted,



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